

## **Remarks**

Claims 1, 3-5, 8-9, 13, and 17-18 are pending. Claims 16 and 19-24 are cancelled in this Response.

Claims 9, 13, 17 and 18 have been allowed.

Claims 1 and 8 were rejected under Section 102(e) as being anticipated by Yorkey 6317218. Claims 3-5 were rejected under Section 103 as being obvious over Yorkey in view of Minagawa 6614550.

With regard to Claim 1, the Examiner asserts that Yorkey teaches logic automatically (1) correlating a user's prior print setting preferences with one or more characteristics of the current document data and (2) selecting, from among the prior print settings, a print setting best suited to the user's prior print setting preferences, as recited in Claim 1. This assertion is not correct.

The Examiner cites to Yorkey column 5, lines 60-67 and Fig. 8 as teaching logic that automatically correlates a user's prior print setting preferences with one or more characteristics of the current document data. So far as Applicants can tell, there is nothing in Fig. 8 that even remotely suggests performing any kind of correlation in general, and specifically not correlating in a user's prior print setting preferences with a characteristic of the current document data. Similarly, there is nothing the passage from Yorkey cited by the Examiner, which is quoted below, that teaches these limitations from Claim 1.

"According to the adaptive mode of the printer 12, and particularly when the automatic adaptive setting is selected, the software maintains a count of the number of consecutive monochrome pages that have been printed with the paper feed path 40 in the color position 48 since the last color page was printed, compares this count with a calculated value representing the maximum number of consecutive monochrome pages to be printed before changing the printer feed." Yorkey column 5, lines 60-67.

Even it is assumed for purposes of argument only that the comparison mentioned in this passage constitutes the claimed correlating, Yorkey still says nothing about comparing a user's prior print setting preferences with characteristics of the current document. On the contrary, Yorkey says specifically that he is comparing a count of

actual pages printed under certain conditions with a calculated value for the maximum number of pages that can be printed under those conditions. Applicants fail to see how this passage has any relevance at all to the limitations of Claim 1. If the Examiner disagrees, he is respectfully requested to explain in detail how either Fig. 8 and/or the page count comparison in Yorkey supports the rejection of Claim 1. Absent such a showing, the rejection of Claim 1 and its dependent claims should be withdrawn.

With regard to Claim 8, the Examiner asserts that Yorkey teaches logic automatically (1) gathering prior document data relating to a user's preferred print setting associated with the prior document data and (2) selecting a print setting best suited to the user's preferred print setting associated with the prior document data.

The Examiner cites to Yorkey Fig. 8 and column 1, lines 65+ as teaching gathering prior document data relating to a user's preferred print setting associated with the prior document data. So far as Applicants can tell, there is nothing in Fig. 8 that even remotely suggests gathering data relating to a user's preferred print setting associated with prior document data. Yorkey Fig. 8 does not mention a user's preferred print settings. Similarly, the passage from Yorkey cited by the Examiner, which is quoted below, does not mention gathering data relating to a user's preferred print settings.

"The data stored may be information such as the identity of prior users, the applications utilizing the printer, the printer ports from which the print jobs come, the number of sheets printed in color, and the length of prior print jobs." Yorkey column 1, line 65 through column 2, line 2.

The Examiner cites to Yorkey Fig. 7 and column 2, lines 8-25 as teaching selecting a print setting best suited to the user's preferred print setting associated with the prior document data. So far as Applicants can tell, there is nothing in Fig. 7 that even remotely suggests selecting a print setting best suited to the user's preferred print setting. On the contrary, Fig. 7 shows only determining whether a print job comes from a source that historically submits long or short or mixed monochrome/color print jobs and then, based on such determinations, configuring the print engine "to print monochrome page in monochrome position." Similarly, the passage from Yorkey cited

by the Examiner, which is quoted below, does not mention selecting a print setting best suited to the user's preferred print setting.

"An object of this invention is to provide a method and apparatus for printing both monochrome and color images on sheets of media that have minimal wear on the components.

Another object of this invention is to provide a method and apparatus for printing both monochrome and color images on sheets of media that have low maintenance costs.

A further object of this invention is to provide a method and apparatus for printing both monochrome and color images on sheets of media that are reliable.

A still further object of this invention is to provide a method and apparatus for printing both monochrome and color images on sheets of media that optimizes the performance of the printer while minimizing wear on components.

Other objects of this invention will be readily perceived from the following description, claims, and drawings." Yorkey column 2, lines 8-25.

Again, if the Examiner disagrees, he is respectfully requested to explain in detail how the cited figures and text in Yorkey might reasonably be interpreted as teaching these limitations in Claim 8. Absent such a showing, the rejection of Claim 8 should be withdrawn.

All pending claims are felt to be in condition for allowance.

The foregoing is believed to be a complete response to the pending Office Action.

Respectfully submitted,

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